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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,849	02/06/2004	Masami Tsuruta	CTW-028	7173
959	7590	11/01/2005	EXAMINER	
LAHIVE & COCKFIELD, LLP. 28 STATE STREET BOSTON, MA 02109			LEE, Y MY QUACH	
			ART UNIT	PAPER NUMBER
			2875	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/773,849	TSURUTA ET AL.	
	Examiner	Art Unit	
	Lee Y Quach	2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/5/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-13 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Response to Arguments***

1. Applicant's arguments filed August 5, 2005 have been fully considered but they are not persuasive. Applicant states that Hayakawa presents a solution to a problem regarding how to find an electric power tool that was accidentally left in a poorly illuminated environment and teaches the selfluminous component emitting visible light for a short period of time while applicant's invention is to provide an electric power tool with at least one component that remains selfluminous for an extended period after use in low light environments so as to ensure continued visibility of the tool. It should be noted that the period of time for the selfluminous component to remain self-illuminated is irrelevant since this feature upon which applicant relies is not recited in the rejected claims. Claim 1 states that at least one component of the electric power tool is selfluminous and this component being capable of storing at least part of the light emitted from the light source and emitting light. Applicant also argues that Horiyama teaches an adapter for use with an electric power tool and one skilled in the art would not be motivated to combine Hayakawa with Horiyama since they are directed to different problems. While Hayakawa and Horiyama may be directed to different problems, however, this does not mean that there is no motivation to combine these references. The motivation for combining these references is what the combination of disclosures would have suggested to one of ordinary skill in the art. It is not necessary that the motivation to make the modification be expressly suggested or articulated the changes or improvements that applicant has made. It should be noted that both Hayakawa and Horiyama are directed to electric power tools that are illuminated in the dark environment. Although Hayakawa does not address its use with a light source but Horiyama does address the use of a light source with the power tool, and one person skilled in the art merely cited Horiyama for the purpose of providing the power tool of Hayakawa with a light source so that not only any objects located in front of the power tool or different directions of and around the power tool of Hayakawa can be illuminated but the self-luminous component of Hayakawa can also be charged, while using the power tool, by directly exposing the self-luminous component to the light emitted from the light source, for self illuminating at a later time during

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poorly illuminated environment. Accordingly, the rejection of claims 1 to 4 and 6 to 12 in view of Hayakawa and Horiyama remains and repeats as followed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Flury et al.

Flury et al. show a light source capable of emitting light (paragraph 0037, lines 10 to 11), at least one component (12, 30, 35, 40) of an electric power tool (10) at least part of which is selfluminous, the component being a removable component (paragraph 0038, lines 2 to 3) capable of storing at least part of the light emitted from the light source and emitting light (paragraph 0042, lines 2 to 3), and the component disposed where the component is directly exposed to the light emitted from the light source (paragraph 0037, lines 10 to 11)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6 and 8 to 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayakawa (JP 138269, prior art cited by applicant) in view of Horiyama et al. (prior art previously cited).

Hayakawa discloses an electric power tool comprised of at least one component at least part of which is self-luminous with the component capable of storing at least part of the light emitted from light source and emitting light, the self-luminous component provided with self-luminous characteristics disposed on the part of the power tool such as the components (2, 8 ...)

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operated by a user, the self luminous component also consisting of the attachments (4) to the power tool, and the self-luminous component provided with self-luminous characteristics by coating of at least one self-luminous material thereon or by mixing of at least one self-luminous material therein during the manufacturing of the component. However, Hayakawa does not disclose that the self-luminous component directly exposed to the light emitted from a light source and irradiated by the light source.

Horiyama et al. teach a flexible light source (26) coupled to an electric power tool. This flexible light source can be manually adjusted to illuminate different directions of and around the power tool including any objects located in front of the tool bit.

It would have been obvious to one skilled in the art to provide the power tool of Hayakawa with a flexible light source, as shown by Horiyama et al., so that not only any objects located in front of the tool bit or different directions of and around the power tool can be illuminated but the self-luminous component can also be charged, while using the power tool by directly exposing the self-luminous component to the light emitted from the light source, for self illuminating at a later time during poorly illuminated environment.

6. Claims 1 to 4 and 6 to 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horiyama et al. (prior art previously cited) in view of Hayakawa (JP 138269, prior art cited by applicant).

Horiyama et al. disclose an electric power tool comprised of a flexible light source (26) capable of emitting light, a main housing (46) coupled to a rear end of a gear housing, the light source disposed at a front end of the main housing on an underside of the gear housing (figure 7), an annual component (47) mounted around a front end of the gear housing immediately forward of the light source, an on/off trigger (49), a switch lever (28), a battery pack (31), a hook (76) for hanging the power tool on a structure, and at least one bit (figure 7). However, Horiyama et al. do not disclose at least one component provided with self-luminous characteristics disposed on the part of the power tool selected from the components operated by a user or attachments to the power tool such as on/off trigger or an annual shape component mounted around a front end of the gear housing, and the self-luminous characteristics provided by coating of at least one self-

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luminous material on the component or by mixing at least one self-luminous material in the component during the manufacturing of the component.

Hayakawa teaches at least one component at least part of which is self-luminous with the component capable of storing at least part of the light emitted from light source and emitting light, the self-luminous component provided with self-luminous characteristics disposed on the part of the power tool such as the components (2, 8 ...) operated by a user, the self luminous component also consisting of the attachments (4) to the power tool and an annular shape component (10) mounted around a front end of the gear housing, and the self-luminous component provided with self-luminous characteristics by coating of at least one self-luminous material on the component or by mixing of at least one self-luminous material in the component during the manufacturing of the component.

It would have been obvious to one skilled in the art to provide the part of the power tool of Horiyama et al. such as the components operated by a user such as on/off trigger, the annual shape component mounted around a front end of the gear housing, and/or the attachments to the power tool with self-luminous characteristics by coating of at least one self-luminous material thereon or by mixing of at least one self-luminous material therein, as shown by Hayakawa, so that the components on the part of the power tool can be charged by the light emitted from the light source while using the power tool in order for the components of the power tool to be self-illuminated at a later time during poorly illuminated environment for preventing the power tool from being left out of the specific place.

7. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

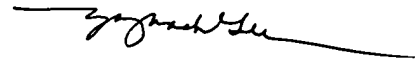
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is 571-272-2815.

Y. Q.
October 27, 2005


Y Quach Lee
Patent Examiner
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